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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,402	02/21/2002	Masato Nakade	TAN-296	5644
7590 07/27/2004 SHERMAN & SHALLOWAY 413 N. WASHINGTON STREET ALEXANDRIA, VA 22314			EXAMINER FUBARA, BLESSING M	
			ART UNIT	PAPER NUMBER

1615

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/078,402	<b>Applicant(s)</b> NAKADE ET AL	
	<b>Examiner</b> Blessing M. Fubara	<b>Art Unit</b> 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7,9-11,14,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-11,14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/10/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Examiner acknowledges receipt of request for extension of time, IDS, amendment and remarks filed 02/10/04. Claims 1-3, 5-7, 9-11, 14, 16 and 17 are pending.

#### ***Claim Rejections - 35 USC § 112***

1. The rejection of claims 1-11 and 14-17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn because the generic claims are amended and applicants' argument is persuasive.

#### ***Information Disclosure Statement***

2. Examiner acknowledges and thanks applicants for providing references on Form PTO 1449 in response to the statement that the citation of references in the specification will not be considered because no citation of the disclosed references was made. The references provided are considered and are made of record in the application.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5, 14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Horino et al. (US 6,200,580).

Horino discloses a powder material where metal such as titanium is covalently bonded to silicon via oxygen atom (column 13, lines 40-47 and example 1). Horino does not specifically disclose the surface area of the metal oxide but indicates that the amount of the silicone relative to the surface area of the metal oxide is important for the texture of the cosmetic as it relates to touch, adhesion to the skin, color extension and the inhibition of flocculation of the particles (column 8, lines 9-18). The teaching of HORINO meets the limitations of the claims.

5. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

6. Claims 1-3, 5-7, 9, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibasaki et al. (US 5,843,525).

Shibasaki discloses treating a metal oxide having a specific surface area of from 5 to 500  $\text{m}^2/\text{g}$  with a silane coupling agent; the fine particles are further treated with organopolysiloxane so that the organosiloxane becomes bonded to the surface of the particles in a stable bond (abstract, column 2, lines 30-45). A point along the surface area continuum of 5 to 500  $\text{m}^2/\text{g}$  surface area would anticipate larger than 50  $\text{m}^2/\text{g}$ . Example 2 of Shibasaki discloses preparation of titanium oxide organopolysiloxane and heating is involved in the process which would imply that the metal be inherently covalently linked to the silicon atom. Shibasaki meets the limitations of the claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 10, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horino et al. (US 6,200,580).

Horino discloses a powder material where a metal such as titanium is covalently bonded to silicon via oxygen atom. Regarding the application of heat in preparation of the powder, Horino disclosed a heating step as can be found in example 1 and the person of ordinary skill would have the know how to determine appropriate temperature for the process. However, Horino does not disclose the surface area of the particles except that the ratio of the siloxane to the surface area of the particles is important to the cosmetic as it relates to texture of the cosmetic such as touch, adhesion to the skin, color extension and the inhibition of flocculation of the particles as discussed above. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine the particle size. One having ordinary skill in the art would have been motivated to use the appropriate particle size with the expectation of producing a cosmetic that has the desired texture in terms of touch, feel, adhesion to the skin, color extension and inhibition of flocculation of the particles.

**Other Matters:**

9. The disclosure is objected to because of the following informalities: In formula (1), page 3 and formula (2), page 4, there is no oxygen between silicons on the right of the formula.

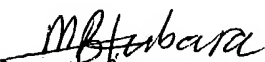
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Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Blessing Fubara  
Patent Examiner  
Tech. Center 1600